

Remarks

5 **The defective Declaration**

A declaration in which the defects have been cured has been attached to this response.

The amendments to the Specification, Drawing, and Claims

Applicant's attorney has reviewed the Specification, Drawing, and Claims and has
 10 corrected the defects objected to by Examiner and other defects discovered during the
 review as well. Examiner will immediately see that the corrections add no new matter to
 the Specification and Drawing and that the claims as amended are fully supported by the
 Specification as filed. The amendments to the Specification, Drawing, and Claims
 consequently overcome Examiner's objections thereto.

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Traversal of the rejections of the claims

Though Examiner has rejected various ones of the claims under 35 U.S.C. 112, second
 paragraph as being indefinite and under 35 U.S.C. 103(a), as being obvious, the actual
 basis for all of the rejections is Examiner's belief that certain claim limitations which
 20 Examiner admits are not disclosed in the cited references are "nonfunctional" and
 consequently "will not distinguish the invention from the prior art in terms of
 patentability". (Office Action, end of ¶8). It is not clear why Examiner believes that the
 presence of claim limitations which are "nonfunctional" renders a claim indefinite under
 35 U.S.C. 112, ¶2; for the proposition that "nonfunctional" elements will not distinguish a
 25 claim from the prior art under 35 U.S.C. 102 or 103, Examiner relies on *In re Gulack*,
 703 F.2d 1381 (Fed. Cir. 1983) and *In re Lowry*, 32 F.3d 1579, (Fed. Cir. 1994) (Office
 Action, ¶23). In the following, Applicant's attorney will show that the rejections under
 35 U.S.C. 112, ¶2 are without basis because whether a claim limitation is "nonfunctional"
 has nothing whatever to do with whether a claim is indefinite and will show that the
 30 rejections under 35 U.S.C. 103(a) are without basis because the claim limitations are in
 fact functional by the standard set forth in *Gulack* and *Lowry, supra*.

The rejections under 35 U.S.C. 112, ¶2

Examiner expresses his basis for rejecting dependent claims 2-23, 39-62, 64-94, and 96-125 under 35 U.S.C. 112, ¶2 as follows:

5 These rejections are made to point out nonfunctional descriptive material being claimed that does not alter how the method steps are to be performed to achieve the utility of the invention. (Office Action, ¶10).

10 The rejection is of course moot if Applicant's attorney shows that the claim limitations are in fact functional, but it is also not a proper ground for rejection of a claim under 35 U.S.C. 112 ¶2, and Applicant's attorney believes it is worthwhile here to show why it is not.

15 The underlying problem with the rejections under 35 U.S.C. 112, ¶2 is that Examiner is confusing the purpose of 35 U.S.C. 112, ¶2 with the purpose of 35 U.S.C. 102 and 103. The purpose of 35 U.S.C. 102 and 103 is to ensure that an applicant's claimed invention is in fact novel and non-obvious; in the words of 35 U.S.C. 112, ¶2 itself, its purpose is to ensure that the *claims* "particularly point[] out and distinctly claim[] the *subject matter which the applicant regards as his invention*." As expressly set out at MPEP 2173,

20 The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. A secondary purpose is to provide a clear measure of what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention.

25 In the present case, Examiner does not maintain in his rejection that the claim language that forms the basis of the rejection fails to "inform [the public] of the boundaries of what constitutes infringement of the patent", and the very fact that the same language that is
30 the basis of the rejection under 35 U.S.C. 112, ¶2 is the basis of the rejection under 35 U.S.C. 103 shows that the language in question permits "determin[ation] whether the claimed invention meets all the criteria for patentability". The claims thus pass muster under 35 U.S.C. 112 and the rejection is without basis.

It should further be pointed out here that the claims rejected under 35 U.S.C. 112, ¶2 are all *dependent* claims. Where the claim being rejected is a dependent claim, an argument like the one that examiner makes in ¶10 of his Office action cannot provide a basis for rejection. The portion of 35 U.S.C. 112 which governs dependent claims is ¶4, which

5 reads in pertinent part as follows:

...a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. ...

10 As to what a "further limitation" in a dependent claim may be, MPEP 608.01(n) states,

A dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. The test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope. (MPEP Aug. 2001, 600-77)

20 What is at issue in Examiner's rejection is of course "the significance of the further limitation added by the dependent claim", and that simply does not matter under 35 U.S.C. 112 as long as the rejected claims "include[] every limitation of the claim from which it depends" and is therefore a proper dependent claim.

25 *The rejections under 35 U.S.C. 103(a)*

Claims 1, 24, 28, 29, 31, 34-35-37, 38. 63, and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowery. Since there is only a single reference and the rejection excludes those limitations of the invention that are not found in Lowery from consideration in determining patentability, the rejection is more properly a rejection under 35 U.S.C. 102(a) than under 35 U.S.C. 103, but which it makes no difference for the traversal.

Examiner's argument for excluding the limitations of the above claims that are not found in Lowry from consideration in determining patentability is found at ¶ 22 and 23 of the Office Action:

22. Lowry does not expressly show the method of use [sic] processing management information where the computer data represents a portfolio of management concepts and a model with fundamental components of an organization of people, a customer relationship, a program management office, and a scalable process.

23. However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, (Fed. Cir. 1994)

In re Gulack is a printed matter case, and the location cited by Examiner affirms the traditional teaching concerning printed matter:

Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to patentable weight. (*In re Gulack*, 1385)

In re Lowry is one of a number of cases which deal with the issue of the application of the above teaching to data structures in memory. Lowry had invented a new data structure. The Patent Office's Board of Patent Appeals had analogized the new data structure to printed matter and has refused to give the new data structure weight in considering whether the claims were patentable. The Federal Circuit held that the Board had "erred by denying patentable weight to Lowry's data structure limitations" (*In re Lowry*, 1584).

On the way to this holding, the Board cited *In re Bernhart*, 417 F.2d 1395, 1399 (CCPA 1969) for the proposition that "the printed matter cases have no factual relevance where 'the information as defined by the claims requires that the information be processed not by the mind but by a machine, the computer.'" Then the Board determined that Lowry was not claiming merely the information content of a memory, but rather that his claims "require specific electronic structural elements which impart a physical organization on the information stored in memory" (*In re Lowry*, 1583) and are therefore not analogous to

printed matter. Further, even if the data structures were analogous to printed matter, they performed a function, and "Gulack requires no more." (*In re Lowry*, 1584). Because that was so, the data structures were entitled to patentable weight.

When the logic of *In re Lowry* is applied to Applicant's claim 1, it is apparent that

5 Applicant's

first set of computer data representing a model of an organization of people, the model having fundamental components, the first set of computer data including data items representing the fundamental components

10 and

second set of computer data representing a portfolio of management concepts are in fact functionally involved in the method steps. To begin with, the first step of the method "acquir[es]" the first set of computer data, i.e., it organizes the first set of computer data in a memory device. The second step "associat[es] the first set of
15 computer data with a second set of computer data", which organizes the first and second sets of computer data in the memory device so that they are associated with one another in such a way that the association determines how the first and second sets of computer data are processed. The third step "issu[es] a report of management concepts based on the second set of computer data, the report being sorted by fundamental concepts", and
20 here it is seen that the organization of data in memory accomplished in steps (1) and (2) determines how the report is generated in step (3). Moreover, because it is the "management concepts" that are sorted by "fundamental component", the "computer data representing a model of an organization of people" and the "computer data representing a portfolio of management concepts" are also functionally involved in the method steps.
25 Since that is so, the limitations of claim 1 that are not disclosed in Lowery are functionally involved in the method steps and are not "nonfunctional descriptive material". That being the case, the limitations are entitled to patentable weight and Examiner's rejection of claim 1 under 35 U.S.C. 103 is without foundation.

30 As Examiner will immediately see, the same logic applies *mutatis mutandis* not only to claim 1, but also to claims 24, 28, 29, 31, 34-35-37, 38, 63, and 95 and all claims

dependent from those claims. Moreover, when Examiner's rejections under 35 U.S.C. 112, ¶2 are taken in their own terms, the logic renders them moot as well.

Conclusion

5 Applicant has amended his Specification, Claims, and Drawing to overcome Examiner's objections thereto, has added no new matter by way of the amendments, and has traversed all of Examiner's rejections of the claims. Applicant has thus been completely responsive to Examiner's non-final Office action as required by 37 C.F.R. 1.111(b) and respectfully requests that Examiner reconsider his rejections as provided by 37 C.F.R. 10 1.111(a). A petition under 37 C.F.R. 1.136 for a one-month extension of time and a check for the requisite fee are attached. Please charge any additional fees required for the amendment or refund any overpayments to deposit account number 501315.

15 Respectfully submitted,

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Goals

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Have profitable products for every segment	75,000	250,000	5	33w
Top Goal Total:		\$825,000.00	\$5,250,000.00	
Agile Manager				

Fig. 15